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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/029,832

12/27/2001

Jack E. Haken

US010712

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03/13/2006

PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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EXAMINER

WEBB, JAMISUE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 03/13/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/029,832  
Filing Date: December 27, 2001  
Appellant(s): HAKEN, JACK E.

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Jack E. Haken  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 1/10/06 appealing from the Office action  
mailed 12/07/05.

**MAILED**

**MAR 13 2006**

**GROUP 3600**

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The 103(a) over a combination of Ohler et al. and Kraisser et al. rejection for Claims 1-8, 10, 11, 13 and 14, and subsequently over O-Meara for Claim 6. The only remaining rejection in the case is Claim 13, which stands rejected under 35 U.S.C. 101.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

##### ***Claim Rejections - 35 USC § 101***

Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to a statutory class of an apparatus, which is an electrical signal that contains information. An electrical signal is a non-tangible object, it is not being received anywhere nor is it being transmitted. There appellant is merely claiming the signal itself, which is considered to be non-statutory subject matter.

#### **(10) Response to Argument**

First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

"The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." Corning v. Burden, 56 U.S. (15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which

perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See *American Disappearing Bed Co. v. Arnaelsteen*, 182 F. 324, 325 (9th Cir. 1910), *cert. denied*, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. *Lorillard v. Pons*, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of

the interpretation of manufacture in American Fruit Growers when it passed the 1952 Patent Act.

A manufacture is also defined as the residual class of product. 1 Chisum, § 1.02[3] (citing W. Robinson, *The Law of Patents for Useful Inventions* 270 (1890)). A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

Furthermore, the information the electrical signal carries, is considered to be non-functional descriptive material. Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. § 101. Certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture or composition of matter. USPTO personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. § 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that

recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process. For the instant invention, the claims state that the electrical signal is modulated with information to implement the sending and receiving steps, however, the independent claim, still allows for the sending and receiving steps to be done manually over the phone, therefore the information the electrical signal provides, is not functionally related to the steps of receiving and sending. The steps of receiving and transmitting are performed the same regardless of what type of information is present in the signal.

The appellant has argued that a signal is in fact tangible, due to the fact the dictionary definition of tangible is a) capable of being perceived especially by the sense of touch, b) capable of being precisely identified or realized by the mind, or c) capable of being appraised at an actual or approximate value. The appellant then goes on to state that a data modulated signal is unquestionably capable of being perceived through the use of suitable circuitry such as found in a cellular phone (for example) and is therefore real in the sense that it can be detected and therefore exists; it is capable of being precisely identified such as through the use of such circuitry; and further capable of being appraised at an actual or approximate value when the signal is demodulated by suitable receiving circuitry. While a signal may be realized by the use of circuitry and computer equipment, the dictionary definition clearly states that in order for something to be tangible, it must be capable of being perceived especially by the sense of touch or

precisely identified or realized by the mind. An electrical signal cannot be perceived by touch, nor can it be perceived by the mind. An electrical signal requires the use of circuitry or a computer to be perceived or identified. A person cannot perceive or identify a signal without the use of computer equipment, nor can a person be capable of appraising at an actual or approximate value, unless the signal is demodulated by suitable circuitry. Therefore the electrical circuit itself is not considered to be statutory subject matter, due to the fact that it in itself is not tangible. Claim 13, where as it states they are transmitted on a cellular wireless communication system, is drawn to the actual electrical signal itself, which is considered to be non-statutory subject matter.

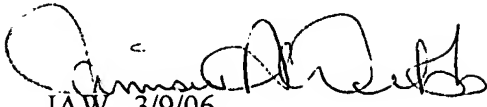
#### **(11) Related Proceeding(s) Appendix**


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.




Respectfully submitted,

  
JAW 3/9/06

  
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